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IN THE

Supreme Court of the United States

OCTOBER TERM, 1949

No. 325

FORREST H. SMITH, *et al.*,

Petitioners,

vs.

GENERAL FOUNDRY MACHINE COMPANY, Incorporated, *et al.*,

Respondents.

REPLY BRIEF FOR PETITIONERS IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioners.

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The brief filed by respondents completely misstates petitioners' position.

It is petitioners' position that having found that the patent claims *did* embrace within their terms the respondents' structure, the motion for summary judgment should have been denied and the question of whether or not the claims were broader than justified by the state of the art should have been left for decision *with the question of validity* upon the trial of the case.

Respondents in paragraph IV of their summary of argument, page 4 of their brief say:

> "It is well settled that the claims of a patent are always to be read and interpreted in the light of the patent specification."

The phrasing of this statement implies that the claims of a patent depend for their meaning upon the specification—this is not the case. It has always been the rule that the specification may be resorted to only when the language of the claims is ambiguous. *Evans* v. *Eaton,* 16 Wheat. 454, 506. Unless it is ambiguous a claim must stand or fall on its own. *Altoona Theatres* v. *Tri-Ergon Corp.,* 294 U. S. 477, 487.

In *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.,* 336 U. S. 271, 277, this Court specifically held that where the claims "are free from ambiguity which might justify resort to the specifications" they must be read in accordance with their specific terms.

We do not mean that a claim must always be literally construed. The *evidence* submitted at the trial may develop facts which show that the apparently plain language of the claims does not in fact define the patentee's invention. In other words, the *evidence* may establish an ambiguity which is not apparent on the face of the patent.

But this is a motion for summary judgment for non-infringement. On such a motion "the complaint must be viewed in the light most favorable to the plaintiff and the complaint should not be dismissed unless it appears to a certainty that the plaintiff would not be entitled to relief under any state of facts which could be proved in support of his claim." *Frederick Hart & Co., Inc.* v. *Recordgraph Corporation,* 169 F. 2d 580, 581 (C. C. A. 3). To read into the claims limitations not therein expressed is not viewing "the complaint in the light most favorable to the plaintiff."

The Court of Appeals in its decision (R. 140) asserts that "the range of equivalents depends upon the extent and nature of the invention." The rule so stated is well established, but it is petitioners' position that the extent and nature of the invention, except as defined in the patent claims, should not be determined on motion for summary

judgment, and *cannot* be decided in this case without deciding "genuine issue of material fact" (Rule 56, Federal Rules of Civil Procedure).

The respondents' circulars (R. 36, 110) claim for the accused structure with two burners the same accurate temperature regulation that is asserted in the patent to be obtained by a plurality of burners. Petitioners contend that the respondents' construction is the equivalent of the patented construction. Respondents assert that it is not. This is a "genuine issue of material fact."

The Court of Appeals relies for support of its decision of this question of fact—that two burners are not enough—on an affidavit filed by petitioners in another case (R. 141), ignoring petitioners' assertion that the affidavit in question related to a different type of installation wherein no flues were employed. In accepting this affidavit as material evidence in this case the Court of Appeals for the Fourth Circuit also decided a "genuine issue of material fact."

In deciding that the claims were not infringed as subcombination claims to a novel and patentable arrangement of flues and heaters regardless of whether the number of heaters employed were sufficient to accomplish the principal object of patentee's invention the Court of Appeals also decided fact issues not presented by the motion.

Conclusion

This case presents an important question of procedure. We know of no case—and respondents have cited none—where this Court or any other court has granted a motion for summary judgment for non-infringement where the language of the claims was plain and unambiguous and squarely embraced the accused structure.

The Summary Judgment Rule (56) when properly applied no doubt contributes significantly to the simplification of the Federal Procedure which was one of the objects of the new Rules. It was not, however, the purpose of the Rule to require litigants to substitute the summary judgment procedure for trial in open court.

The metes and bounds of Rule 56 have not been laid down by this Court, but should be. Is the Summary Judgment procedure to be confined strictly to questions of law arising out of admitted facts as decided by the Court of Appeals for the Third Circuit in *Hart* v. *Recordgraph Corporation, supra,* or may the admitted facts—the patent claims and the accused structure—be modified by *inferences* of fact drawn from a *res gestae* of excerpts from proceedings in other cases, etc., as has been done by the Court of Appeals for the Fourth Circuit in this case?

Respectfully,

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioners.

New York, N. Y.
November 1, 1949.